

Attorney Docket No. 9066-23DV

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Marsh et al.  
Serial No.: 10/820,186  
Filed: April 7, 2004  
For: CUSHIONING DEVICE FOR FURNITURE

Confirmation No.: 7421  
Group Art Unit: 3676  
Examiner: Carlos Lugo

September 7, 2007

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS'**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which has been extended indefinitely.

**REMARKS**

Applicants hereby request a Pre-Appeal Brief Review (the "Request") of the rejection of Claims 1, 4-11, 13 and 14 in the Final Office Action dated May 7, 2007 (the "Action"). Claims 1, 4, 6-11, 13 and 14 under Section 103(a) were rejected as obvious over U.S. Patent No. 3,952,455 to McAlarney (McAlarney). Claims 1, 4 and 6-11 were rejected under Section 103(a) as obvious over U.S. Patent No. 2,185,161 to Tinnerman (Tinnerman) in view of U.S. Patent No. 1,998,791 to Schanz (Schanz). Claim 13 under 35 U.S.C. 103(a) was rejected as being unpatentable over Tinnerman in view of Schanz and in further view of Wilson. Claim 5 was rejected under Section 102(b) as being anticipated by U.S. Patent No. 2,858,583 to McEvoy ("McEvoy") and under Section 103(a) as being unpatentable over McAlarney in view of McEvoy.

Applicants respectfully submit that all of the claim recitations of the independent claims are not described or rendered obvious, so that one or more elements needed for a *prima facie* rejection under 35 USC §§ 102(b)/103(a) are not present. Therefore, Applicants

respectfully request review of the present application by an appeal conference prior to filing of an Appeal Brief. In the interest of brevity, and without waiving the right to argue additional grounds should this Request be denied, Applicants will point out the Action's omission of one or more essential elements needed for a *prima facie* rejection.

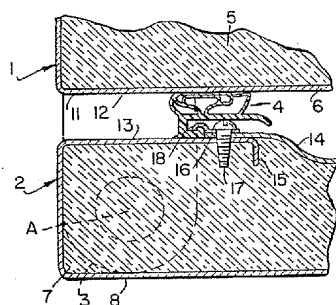
# **I. The Rejections of Independent Claims 1 and 13**

The rejections of independent Claims 1 and 13 based on McAlarney and of Claims 1 and 13 based on Tinnerman in view of Schanz and Wilson are addressed below.

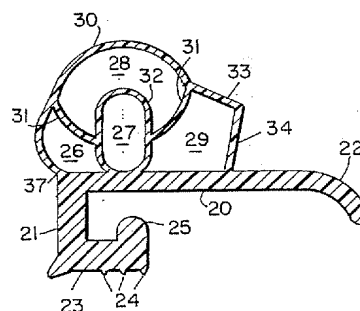
## **A. McAlarney**

Claims 1 and 13 recite that the first and second members of the clip define "a cavity within which one of the first or second furniture components is captured to affix the device thereto." The Examiner identifies elements **21**, **23** and **25** as equivalent to the clip (*see* the Action, page 3). In response to the arguments in Applicants' Paper dated October 25, 2006, the Action states that McAlarney "clearly discloses a frame (1) having a movable member (2) connected to the frame." *See* the Action, page 10.

However, the elements **21**, **23** and **25** do not capture the frame 1 or movable member 2, which are identified by the Examiner as furniture components. Therefore, the elements **21**, **22** and **25** clearly do not define "a cavity within which one of the first or second furniture components is captured to affix the device thereto" as recited in Claim 1.



**FIG. 1**



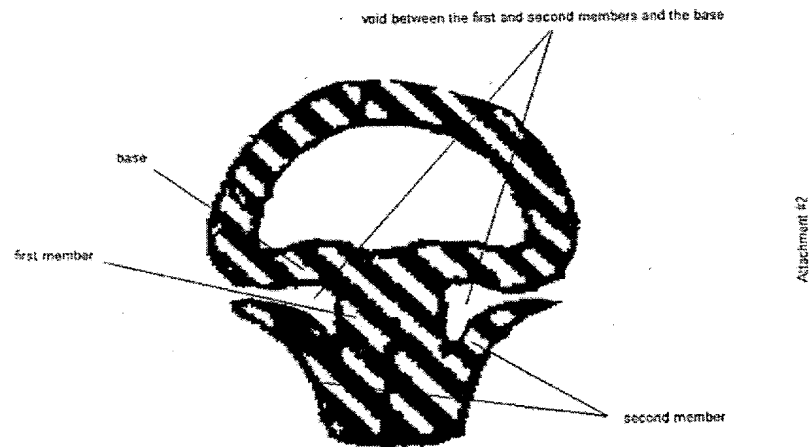
**FIG. 2**

Therefore, McAlarney does not teach or suggest all of the recitations of Claims 1 and 13 as required by § 103.

**B. Tinnerman, Schanz and Wilson**

The Examiner concedes that Tinnerman does not disclose a clip connected to the base member; however, the Examiner takes the position that the projection **15** of Schanz is equivalent to the claimed clip member.

Attachment #2 (reproduced below) was provided by the Examiner in the Action. In response to Applicants' Paper filed October 25, 2006, the Examiner states that Schanz discloses a first member connected to the base member and a second member connected to the first member with reference to Attachment #2. However, Claims 1 and 13 recite that the first member is "attached to one end portion of the base member."



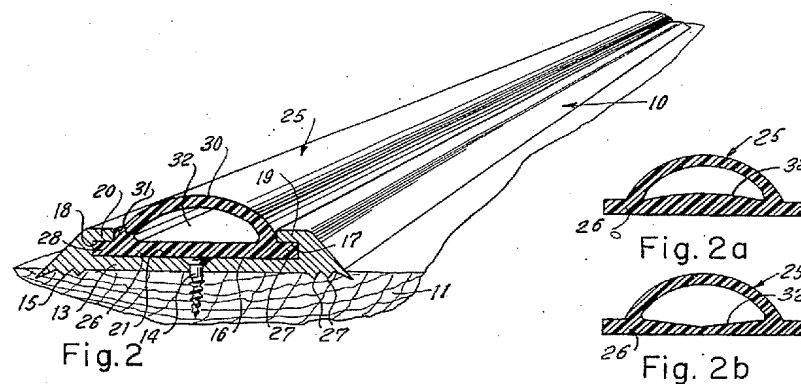
In contrast, the "first member" identified in Attachment #2 by the Examiner's notations extends from the middle portion of the element identified as the base, and therefore, is clearly not attached to one end portion of the base member as recited in Claims 1 and 13. This feature is also not disclosed by Tinnerman (which the Examiner concedes does not disclose a clip) or Wilson (which the Examiner cites as allegedly teaching a planar portion extending away from the cushioning projection). Therefore, Applicants submit that these features are not disclosed or suggested by Tinnerman or Schanz and/or Wilson as required by § 103.

**II. Rejections of Claim 5**

Claim 5 recites "a planar portion opposite the convex portion [of the cushioning projection], and the planar portion of the projection has a thickness that is less than the

thickness of the base member." The Examiner concedes that McAlarney fails to disclose that the planar portion of the base member across the void has a thickness that is less than the thickness of the base member. The Examiner takes the position that McEvoy teaches a planar portion that has either the same thickness (**Figure 2**), more thickness (**Figure 2a**) or less thickness (**Figure 2b**). See the Action, page 7.

In response to Applicants' arguments in the Paper of October 25, 2006, the Examiner states that "the claim language does not require that [the base member planar portion] is planar from one end to the other so as to maintain the same thickness." See the Action, page 10. The Examiner identifies the weatherstrip seal member **25** as equivalent to the cushioning projection of Claim 5.



However, as illustrated in **Figures 2, 2a and 2b** above, no portion of the weatherstrip seal in McEvoy that is opposite the convex seal member **25** is planar (*i.e.*, flat) and has a thickness that is less than the thickness of the base member. As shown in **Figure 2b**, the portion of the weatherstrip seal **32** opposite the convex seal member **25** has a slope toward the center portion of the seal **32** and as such, is not planar.

Accordingly, neither McAlarney nor McEvoy teach or render obvious all of the recitations of Claim 5 as required by §§ 102 and 103.

### **III. Conclusion**

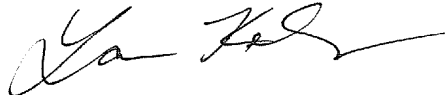
For the reasons discussed above, Applicant submits that one or more elements needed for a *prima facie* rejection under 35 USC §§ 102(b)/103(a) are not present. Therefore,

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Applicant respectfully requests that the present application be reviewed and the outstanding rejection be reversed by the appeal conference prior to the filing of an appeal brief.

It is not believed that an extension of time and/or additional fee(s) is due. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any refund, to our Deposit Account No. 09-0461.

Respectfully submitted,

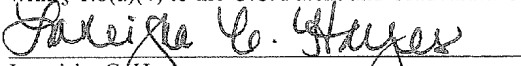


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#### CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office September 7, 2007.

  
Laneisha C. Hayss  
Date of Signature: September 7, 2007